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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,625	04/10/2001	Sonja Eijsbouts	ACH2779US	7654

7590

10/16/2003

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EXAMINER

NGUYEN, CAM N

ART UNIT

PAPER NUMBER

1754

DATE MAILED: 10/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/829,625

Applicant(s)
Eijsbouts

Examiner
Cam Nguyen

Art Unit
1754



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/4/03 (an amendment/response)
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-36 is/are pending in the application.
- 4a) Of the above, claim(s) 32 and 33 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 2, 5-13, 15-21, 23, 25-30, and 34-36 is/are allowed.
- 6) ☒ Claim(s) 4, 22, and 31 is/are rejected.
- 7) ☒ Claim(s) 3 and 24 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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DETAILED ACTION

1. Applicants' remarks and amendments, filed on August 4, 2003, have been carefully considered. Claims 1, 26, & 30 have been amended. Claim 14 has been canceled. New claims 34-36 have been added.

Claims 1-13 & 15-36 are now pending in this application.

2. Applicants affirmed the election of Group I, claims 1-31, in Paper No. 6 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

3. This application contains claims 32-33 which drawn to an invention nonelected without traverse in Paper No. 6. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Objections

4. Claims 3 & 24 are objected to because of the following informalities:
- A. In claim 3, line 2, "boiling" should be --boiling point--.
 - B. In claim 24, line 1-2, the claim should be rewritten as follows:

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--The process of claim 1 wherein the Group VI metals are Mo and W, and the Group VIII metals are Co and Ni--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112 (Second Paragraph)

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 4 & 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Regarding claim 4, the proper Markush terminology is --wherein the organic liquid is selected from the group consisting of white oil, gasoline, diesel, gas oil, and mineral lube oil--.
See MPEP § 2173.05(h).

B. Claim 22 recites the limitation "the Group VIB metal" in line 1. There is insufficient antecedent basis for this limitation in the claim. The independent claim 1 recites "Group VI metal" but not "Group VIB metal", thus, there is no basis for recitation of "Group VIB metal".

Claim Rejections - 35 USC § 102(b)/103

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 31 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Seamans et al., "hereinafter Seamans", (PCT WO 94/25157).

Seamans discloses an activated catalyst, wherein the catalyst to be activated is a supported metal catalyst containing elemental sulfur, particularly a Group VIB and/or Group VIII metal catalyst (see page 16, ln 15-17).

Seamans teaches the claimed catalyst, thus anticipates the claim.

Recitation of product-by-process limitation in the claim is noted. While the catalyst of the reference is not made by the same process, the catalyst made is the same as claimed because it contains the same metal components. See *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985); *In re Brown*, 173 USPQ 688, 688 (CCPA 1977); *In re Fessman*, 180 USPQ 324, 326 (CCPA 1977).

See also MPEP 2113.

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9. Claim 31 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over de Jong et al., "hereinafter de Jong", (US Pat. 5,139,990).

De Jong discloses an activated catalyst which contains a carrier with deposited thereon one or more metals or compounds of metals, such as oxides, the metals is selected from a group including Group VIB and Group VIII of the Periodic Table (see col. 3, ln 41-46).

De Jong teaches the claimed catalyst, thus anticipates the claim.

Recitation of product-by-process limitation in the claim is noted. While the catalyst of the reference is not made by the same process, the catalyst made is the same as claimed because it contains the same metal components. See *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985); *In re Brown*, 173 USPQ 688, 688 (CCPA 1977); *In re Fessman*, 180 USPQ 324, 326 (CCPA 1977). See also MPEP 2113.

Allowable Subject Matter

10. Claims 1-13, 15-30, & 34-36 are not being rejected under the art rejection because they contain allowable subject matter. A statement of reason(s) for allowance of the claimed subject matter is the same as indicated in previous office action.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

12. Claims 1-13 & 15-36 are pending. Claims 4, 22, & 31 are rejected. Claims 3 & 24 are objected. Claims ³²⁻³³~~31-32~~ remain withdrawn due to nonelected (distinct) invention. Claims 1-2, 5-13, 15-21, 23, 25-30, & 34-36 are allowed.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Cam Nguyen, whose telephone number is (703) 305-3923. The examiner can normally be reached on M-F from 8:30 am. to 6:00 pm, with alternative Monday off.

The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 (before finals) and (703) 872-9311 (after-final).

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Nguyen/cnn *CNN*

October 12, 2003

Cam Nguyen

Cam Nguyen

Primary Examiner

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